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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057967
Party	Defendant Space IBZ Planet, S.L.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Reg. No. : 4257881
Mark : SPACE DANCE CHICAGO & Device
Respondent : Space IBZ Planet, S.L.

Club Space Management, LLC)	
d/b/a Club Space)	
)	
Petitioner,)	Cancellation No. 92057967
)	
v.)	
)	
Space IBZ Planet, S.L.,)	
)	
Respondent.)	

**ANSWER AND AFFIRMATIVE DEFENSES IN RESPONSE TO PETITION TO CANCEL
REGISTRATION NO. 4,257,881 BASED ON FRAUD, LIKELIHOOD OF CONFUSION AND
PETITIONER'S PRIOR USE, AND RESPONDENT'S NON-USE**

Respondent, Space IBZ Planet, S.L. ("Respondent"), by its undersigned attorneys for its Answer and Affirmative Defenses in Response to Petition to Cancel Registration No. 4257881 Based on Fraud, Likelihood of Confusion and Petitioner's Prior Use, and Respondent's Non-Use filed by Club Space Management, LLC d/b/a Club Space ("Petitioner"), alleges and states as follows:

1. For thirteen years, Petitioner has operated a nightclub, "Club Space," currently located at 34 N.E. 11th Street, Miami, Florida, using the mark CLUBSPACE and the design mark shown below (collectively referred to as "CLUB SPACE Mark"):



See Federal Trademark Registration No. 2,655,445 (registered December 3, 2002) (covering "restaurant, nightclub, bar and cabaret services" in International Class 042), a copy of which is annexed hereto as **Exhibit A**.

Answer: Admitted to the extent that Exhibit A purports to be a true and correct copy of a Certificate of Registration issued by the USPTO. Respondent lacks sufficient information with which to form a belief as to the truth or falsity of the remaining

allegations, whether express or implied, in this Paragraph 1 and therefore denies the same.

2. Petitioner's CLUB SPACE Mark has a high degree of distinctiveness and marketplace recognition, due largely to the duration and extent of Petitioner's use, advertising, and publicity of the CLUB SPACE Mark in commerce. See numerous promotional flyers distributed to the public as early as 2000, copies of which are annexed hereto as **Exhibit B**; photographs of celebrities taken at Club Space at 34 N.E. 11th Street, Miami, Florida, copies of which are annexed hereto as **Exhibit C**; "Rihanna Is A Pot-riotic Partier In Miami!" PEREZHILTON.COM, Aug. 12, 2013, *available at* <<http://perezhilton.com/cocoperez/2013-08-12-rihanna-american-10-deep-flag-weed-t-shirt-miami>>, *last visited* Sept. 23, 2013, a copy of which is annexed hereto as **Exhibit D**.

Answer: Admitted to the extent that Exhibits B-D purport to be advertisements.

Respondent lacks sufficient information with which to form a belief as to the truth or falsity of the remaining allegations, whether express or implied, in this Paragraph 2 and therefore denies the same.

3. Since December 1, 1999, Petitioner has used the CLUB SPACE Mark continuously in connection with the operation of its nightclub, "Club Space." See **Exhibit B**.

Answer: Respondent lacks sufficient information with which to form a belief as to the truth or falsity of the allegations, whether express or implied, in this Paragraph 3 and therefore denies the same.

4. Petitioner has also used the CLUB SPACE Mark:

a. On its website, blog, and other social media:

[IMAGE INTENTIONALLY OMITTED]

Source: www.clubspace.com/

[IMAGE INTENTIONALLY OMITTED]

Source: www.clubspace.com/blogs/

[IMAGE INTENTIONALLY OMITTED]

Source: www.facebook.com/ClubSpace/

b. In connection with Podcasts (e.g., “Club Space Podcast”; “Space Nation Podcast”; and “Space Miami Podcast”):

[IMAGE INTENTIONALLY OMITTED]

Source: www.apple.com/us/podcast/space-miami-podcast/id468802120/

[IMAGE INTENTIONALLY OMITTED]

Source: www.clubspace.com/

c. In connection with its innovative events and parties hosted on the Miami dance club scene (e.g., www.clubspace.com/events/):

[IMAGES INTENTIONALLY OMITTED]

Source: www.clubspace.com/; www.clubspace.com/events/

Answer: Respondent lacks sufficient information with which to form a belief as to the truth or falsity of the allegations, whether express or implied, in this Paragraph 4 and therefore denies the same.

5. Petitioner and the CLUB SPACE Mark have also received prominent media attention in the past thirteen years. For example:

Rave all you want about the fabulous South Beach nightlife. But serious clubbers have known for years that Space in downtown Miami is the place to go when you really want to let loose and lose yourself in the best progressive house and trace beats in the world—till way past sunrise.

Hamersly, Michael, “Club Space turns 10,” MIAMI.COM, Nightlife, May 20, 2010, *available at* <<http://www.miami.com/club-space-turns-10-article/>>, *last visited* Sept. 23, 2013, a copy of which is annexed hereto as **Exhibit E**; see also Pajot, S., “Space Miami’s Louis Puig on His Club’s 12th Anniversary: ‘We Have Dominated, Where Others Predicted Our Demise,’” Miami New Times, Blogs, May 12, 2012, *available at* <http://blogs.miaminewtimes.com/crossfade/2012/05/space_12th_anniversary_louis_puig_comments.php/>, *last visited* Sept. 23, 2013, a copy of which is annexed hereto as **Exhibit F**.

Answer: Respondent lacks sufficient information with which to form a belief as to the truth or falsity of the allegations, whether express or implied, in this Paragraph 5 and therefore denies the same.

6. As described in the Miami New Times, “[i]t’s impossible to speak of local nightlife and electronic dance music culture without mentioning Space, Miami’s quintessential megaclub.” Levisman, Sean, “Give ‘Em Space,” MIAMI NEW TIMES, Calendar, May 6, 2010,

available at <<http://www.miaminewtimes.com/2010-05-06/calendar/give-em-space/>>, last visited Sept. 23, 2013, a copy of which is annexed hereto as **Exhibit G**.

Answer: Respondent lacks sufficient information with which to form a belief as to the truth or falsity of the allegations, whether express or implied, in this Paragraph 6 and therefore denies the same.

7. In apparent recognition of this fact, Club Space was recently listed among DJ MAG's "Top 100 Clubs list" (available at <<http://www.djmag.com/content/club-space/>>, last visited Sept. 23, 2013, a copy of which is annexed hereto as **Exhibit H**) (#46) and was voted "Best US Club" at the IDMA 28th Annual International Dance Music Awards, see "28th Annual International Dance Music Awards announce results, name Armin van Buuren as Best Producer," DANCINGASTRONAUT.COM, available at <<http://www.dancingastronaut.com/2013/03/28th-annual-international-dance-music-awardsannounce-results-name-armin-van-buuren-as-best-producer/>>, last visited Sept. 23, 2013, a copy of which is annexed hereto as **Exhibit I**.

Answer: Respondent lacks sufficient information with which to form a belief as to the truth or falsity of the allegations, whether express or implied, in this Paragraph 7 and therefore denies the same.

8. Thus, Petitioner's Club Space and the CLUB SPACE Mark are well known among the general public, and Petitioner has developed strong trademark rights in the CLUB SPACE Mark.

Answer: Denied.

9. Respondent Space IBZ Planet, S.L., is a corporation organized and existing under the laws of Spain, with an address of JUAN DE AUSTRIA 19, EIVISSA (ISLAS BALEARES) E07800, SPAIN ("Respondent"), and is the owner the mark SPACE DANCE CHICAGO and design mark shown below (collectively referred to as the "SPACE DANCE CHICAGO Mark"):

[IMAGE INTENTIONALLY OMITTED]

Answer: Admitted.

10. The SPACE DANCE CHICAGO Mark was registered in the United States on December 11, 2012. See Federal Trademark Registration No. 4,257,881 (registered Dec. 11, 2012) (covering "Entertainment centres, namely, night clubs; cinema theaters; discotheques; entertainment in the nature of laser shows; entertainment in the nature of light shows; entertainment, namely, live performances of a musical band; entertainment, namely, live performances of music concerts and shows; entertainment, namely, live performances of groups of singers," in International Class 041), a copy of which is annexed hereto as **Exhibit J**.

Answer: Admitted.

11. The registration was filed under Section 1(b) based on intent to use.

Answer: Admitted.

12. Respondent's SPACE DANCE CHICAGO Mark is confusingly similar to Petitioner's CLUB SPACE Mark, which was registered 10 years prior, and its registration is likely to create confusion in the marketplace. Without limitation, Respondent's SPACE DANCE CHICAGO Mark and Petitioner's CLUB SPACE Mark both use the defining word "SPACE" in connection with nightclub and entertainment services, and both are used in the same channels of commerce to reach the same set of consumers. As set forth above, Petitioner's CLUB SPACE Mark is highly distinctive and has become well-known among the general public.

Answer: Denied.

13. Petitioner seeks cancellation of Respondent's Registration No. 4,257,881, based on the following grounds:

a. Fraud, namely, Respondent's fraudulent representations to the United States Patent and Trademark Office ("USPTO") that the SPACE DANCE CHICAGO Mark had been used and was in current use in commerce in the United States, when it was not;

b. Petitioner's prior use of the CLUB SPACE Mark, to which Respondent's SPACE DANCE CHICAGO Mark is confusingly similar; and

c. Respondent's non-use of the SPACE DANCE CHICAGO Mark in commerce in the United States.

Answer: The allegations in this Paragraph 13 are legal conclusions to which no answer is required. To the extent an answer is required, Respondent denies the same.

COUNT I

14. Paragraphs 1 through 13c., above, are hereby reiterated and incorporated in this paragraph, as though fully set forth herein.

Answer: Respondent reiterates and incorporates its answers to Paragraphs 1 through 13c, as though fully set forth herein.

15. As indicated above, Respondent's application for the SPACE DANCE CHICAGO Mark was filed under Section 1(b) based on intent to use the SPACE DANCE CHICAGO Mark in commerce in the United States.

Answer: Admitted to the extent that Respondent's application for SPACE DANCE CHICAGO was filed under Section 1(b). The remaining allegations in this Paragraph 15 are legal conclusions to which no answer is required.

16. On April 20, 2010, the USPTO issued a Notice of Allowance for the SPACE DANCE CHICAGO Mark, after which Respondent had six months to file a Statement of Use with the USPTO. See Notice of Allowance, issued Apr. 20, 2010 [Doc. No. 38], a copy of which is annexed hereto as **Exhibit K**.

Answer: Admitted to the extent that Exhibit K purports to be a copy of a document issued by the USPTO on April 20, 2010.

17. Thereafter, Respondent filed four separate requests for an Extension of Time to File Statement of Use, which the USPTO granted. See **Exhibit L** hereto (compilation of (a) Respondent's requests for Extension of Time to File Statement of Use and (b) the USPTO's Extension Approvals).

Answer: Admitted to the extent that Exhibit L purports to be copies of documents filed by Respondent with the USPTO.

18. Ultimately, Respondent filed a Statement of Use with the USPTO on September 24, 2012. See Statement of Use, filed Sept. 24, 2012 [Doc. No. 11], a copy of which is annexed hereto as **Exhibit M**.

Answer: Admitted to the extent that Exhibit M purports to be a copy of materials filed with the USPTO.

19. Respondent's Statement of Use claimed (falsely) that: For International Class 041, the [SPACE DANCE CHICAGO Mark] is in use in commerce on or in connection with all goods or services listed in the application . . . The [SPACE DANCE CHICAGO Mark] was . . . first used in commerce at least as early as 09/18/2012, and is now in use in such commerce. *Id.* In connection with its Statement of Use, Respondent submitted "one" specimen for the class "consisting of a(n) Advertisement." *Id.* and below:

[IMAGE INTENTIONALLY OMITTED]

Answer: Denied.

20. Respondent's representation is false because the SPACE DANCE CHICAGO Mark (a) has not been used in commerce in the United States, and (b) is not currently in use in commerce in the United States. Petitioner's investigation to date has revealed that Respondent

operates no nightclubs, cinema theaters, or discotheques in the United States (and certainly none in connection with the SPACE DANCE CHICAGO Mark). In fact, Respondent has only hosted a handful of single-night parties on isolated occasions—none of which predate Petitioner's use of its CLUB SPACE Mark or constitute a **current** use in commerce.

Answer: Denied.

21. Notably, Respondent's specimen submitted with its Statement of Use is for one such single-night party, which took place years ago:

[IMAGE INTENTIONALLY OMITTED]

November 19, 2012

Answer: Admitted only to the extent that the specimen submitted with the Statement of Use advertised for an event occurring on November 19, 2012. Denied as to the remaining allegations, whether expressed or implied, in this Paragraph 21.

22. It therefore appears that Respondent filed its Statement of Use, attaching the above specimen, fraudulently, in order to induce the USPTO to register Respondent's SPACE DANCE CHICAGO Mark, when it should not have been registered.

Answer: The allegations in this Paragraph 22 are legal conclusions to which no answer is required. To the extent an answer is required, Respondent denies the same.

23. Upon information and belief, Respondent's representations in its Statement of Use and attached specimen were material to the USPTO's decision to register the SPACE DANCE CHICAGO Mark, which Respondent applied for under Section 1(b) based on intent to use in commerce. Without such statements, Respondent would not have been able to prove use in commerce in the United States, and Respondent's application for the SPACE DANCE CHICAGO Mark would have been abandoned.

Answer: The allegations in this Paragraph 23 are legal conclusions to which no answer is required. To the extent an answer is required, Respondent denies the same.

24. Moreover, upon information and belief, Respondent misrepresented its intent to use the SPACE DANCE CHICAGO mark as bona fide at the time of filing its application under 15 U.S.C. § 1051(b). Under the standard set forth in *Honda Motor Co. v. Winkelman*, 90 USPQ2d 1660 (TTAB 2009), unless Respondent is able to provide documentary evidence that demonstrates its intent to use the SPACE DANCE CHICAGO mark in commerce, then such intent is not considered bona fide, and Respondent's statement concerning its intent made in filing the application for registration is rendered false.

Answer: The allegations in this Paragraph 24 are legal conclusions to which no answer is required. To the extent an answer is required, Respondent denies the same.

25. As a result, Respondent's representations to the USPTO described above constitute fraud, invalidating Registration No. 4,257,881 for the SPACE DANCE CHICAGO Mark, and require cancellation.

Answer: The allegations in this Paragraph 25 are legal conclusions to which no answer is required. To the extent an answer is required, Respondent denies the same.

COUNT II

26. Paragraphs 1 through 25, above, are hereby reiterated and incorporated in this paragraph, as though fully set forth herein.

Answer: Respondent reiterates and incorporates its answers to Paragraphs 1 through 25, as though fully set forth herein.

27. As indicated above, Petitioner's CLUB SPACE Mark was registered on December 3, 2002. See **Exhibit A**.

Answer: Admitted to the extent that Exhibit A purports to be a true and correct copy of a Certificate of Registration issued by the USPTO on December 3, 2002. Denied as to the remaining allegations, whether express or implied, in this Paragraph 27.

28. Since its registration over ten years ago, the CLUB SPACE Mark has become distinctive and well known among the general public, and Petitioner has developed strong trademark rights in the CLUB SPACE Mark—due largely to Petitioner's use, advertising, and publicity of the CLUB SPACE Mark in commerce. See **Exhibits B – I**.

Answer: The allegations in this Paragraph 28 are legal conclusions to which no answer is required. To the extent an answer is required, Respondent lacks sufficient information with which to form a belief as to the truth or falsity of the allegations in this Paragraph 28 and therefore denies the same.

29. By contrast, Respondent's SPACE DANCE CHICAGO Mark was registered on December 11, 2012—more than a decade after Petitioner registered and began using the CLUB SPACE Mark in commerce in the United States. See **Exhibit J**.

Answer: Admitted to the extent that Respondent's SPACE DANCE CHICAGO Mark achieved registration on December 11, 2012. Denied as to the remaining allegations, whether express or implied, in this Paragraph 29.

30. Moreover, Respondent's SPACE DANCE CHICAGO Mark is confusingly similar to Petitioner's CLUB SPACE Mark, in that it incorporates the defining word "SPACE" exactly, and the goods and services covered by Respondent's SPACE DANCE CHICAGO Mark are similar, identical, or related to the services that have been offered by Petitioner in connection with its CLUB SPACE Mark.

Answer: The allegations in this Paragraph 30 are legal conclusions to which no answer is required. To the extent an answer is required, Respondent denies the same.

31. As a result, Respondent's registration and use of the SPACE DANCE CHICAGO Mark (if any) is likely to create confusion, mistake, and deception in the marketplace, and would injure and damage Petitioner's prior rights in the CLUB SPACE Mark.

Answer: The allegations in this Paragraph 31 are legal conclusions to which no answer is required. To the extent an answer is required, Respondent denies the same.

32. Respondent's SPACE DANCE CHICAGO Mark should therefore be cancelled in its entirety.

Answer: Denied.

COUNT III

33. Paragraphs 1 through 32, above, are hereby reiterated and incorporated in this paragraph, as though fully set forth herein.

Answer: Respondent reiterates and incorporates its answers to Paragraphs 1 through 32, as though fully set forth herein.

34. Not only does Petitioner have prior rights in/to the CLUB SPACE Mark, but, as explained above, Respondent has never used the SPACE DANCE CHICAGO Mark in commerce in the United States, rendering its registration invalid.

Answer: Denied.

35. Again, based on Petitioner's investigation to date, Respondent operates no nightclubs, cinema theaters, or discotheques in the United States (and certainly none in connection with the SPACE DANCE CHICAGO Mark). It has only hosted a handful of singlenight parties on isolated occasions—none of which predate Petitioner's use of the CLUB SPACE Mark.

Answer: Denied.

36. Therefore, it appears that Respondent's registration for the SPACE DANCE CHICAGO Mark is invalid, based on non-use, and the USPTO should cancel Respondent's registration for the SPACE DANCE CHICAGO Mark in its entirety.

Answer: The allegations in this Paragraph 36 are legal conclusions to which no answer is required. To the extent an answer is required, Respondent denies the same.

AFFIRMATIVE DEFENSES

1. Petitioner's claims are barred under the doctrine of unclean hands.
2. Petitioner's claims are barred pursuant to the equitable defense of laches.
3. Petitioner's claims are barred pursuant to the equitable defense of estoppel.
4. Petitioner's claims are barred pursuant to the equitable defense of acquiescence.

WHEREFORE, Respondent Space IBZ Planet, S.L. respectfully requests that the Petition for Cancellation by Club Space Management, LLC, d/b/a, Club Space be denied and that Respondent's registration remain in full force and effect.

Respectfully Submitted,

/Sean S. Swidler/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION was served this November 11, 2013, by First Class Mail, postage prepaid, on Petitioner's Counsel of Record at the following address:

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By: /Sean S. Swidler/
Sean S. Swidler
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